

REMARKS

Applicant carefully reviewed the Office Action dated August 25, 2004 and notes with appreciation the indication of allowable subject matter in claims 15, 27, 29, 35, 36, 38, 39, 40 and 42. A Request for a One Month Extension of Time is submitted concurrently herewith, thus making the response deadline December 27, 2004. The Examiner is authorized to debit any fee deemed necessary to consider this response from Deposit Account 11-0978.

First addressing the formal issues, the objections to claims 28 and 30 are overcome by the foregoing amendments. Specifically, claim 28 is amended to remove the "whereby" clause including allegedly indefinite word "easily" (even though more than 16,000 issued patents include such a claim limitation), and claim 30 is amended to remove "plate-like" (even though more than 6,000 issued patents include such a claim limitation!) These adjustments not only broaden the claims, but also fully address the Examiner's concerns with regard to indefiniteness. Withdrawn claims 1-12 are also cancelled.

Regarding the substantive issues, claims 13, 14, 23, 26, 28, 31, 37 and 41 stand rejected as "obvious" based on the combination of Huberty et al. (U.S. Patent No. 5,605,222) and Kandra et al. (U.S. Patent No. 2,680,509). Turning first to claim 13, Applicant respectfully traverses the rejection without amendment on the basis that a *prima facie* case of obviousness is lacking. According to the Manual of Patent Examining Procedure, to reject a claim as *prima facie* obvious based on features disclosed in two different references, there must be some suggestion of the desirability of making the combination. Section 2143.01 MPEP, ch. 2100, p. 131 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") (Emphasis in original). If the Examiner does not establish a *prima*

facie case, then Applicant is under no obligation to submit evidence of nonobviousness. Section 2142 MPEP, ch. 2100, p. 110.

Here, it is admitted that primary Huberty et al. reference “does not disclose a slave drive.” While Kandra et al. discloses driving a plurality of rollers using a drive associated with an adjacent conveyor of a potato harvester, these rollers are not a “belt or chain” and are plainly not operating to transfer articles across a gap formed between two conveyors. Instead, these rollers are for segregating product falling onto the second conveyor “in a manner effective to distribute the articles over the full width of the second conveyor” (p. 4, col. 23-25). In light of the different nature of the arrangement shown in Kandra et al., a skilled artisan upon considering its teachings would not at all be motivated to provide the belt-style of transfer conveyor shown in Huberty et al. with a slave drive for any reason. In other words, the “prior art does not suggest the desirability of the combination” being made, which suggestion is instead found only in the Applicant’s specification.

With all due respect, the reasons provided for combining the references are based on merely subjective speculation, rather than any objective evidence that would possibly lead or motivate a skilled artisan to make the combination as proposed. The requirement for such objective evidence in making the *prima facie* case of obviousness is made clear by numerous precedential court decisions.¹ Under these decisions, as well as the above-cited passage from the MPEP, it is clearly not enough that the combination *could* have been made, on which principle the rejection seems to rely as its basis; rather, something in the prior art must actually suggest the

¹ *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002) (“The factual inquiry whether to combine references must be . . . based on objective evidence of record.”).

desirability of making it.² Most if not all inventions arise from a combination of old elements, and if it were merely enough to cite to the various elements in the prior art without a requirement for a motivation or suggestion to make the combination, hardly a patent would issue.³ Furthermore, the law makes clear that reliance on hindsight using Applicant's specification is improper, which here provides the only suggestion of using a slave drive for a transfer conveyor.⁴

With respect to this last point, it should be recognized that conveyor belts and chains were known in the art at the time the invention in the Kandra et al. patent was made more than fifty years ago. Despite the availability of this technology, Kandra et al. fails to mention it as a possibility for one simple reason: substituting a belt or chain for the rollers would result in a segregating device that does not work for its intended purpose. Moreover, despite the lengthy period since the issuance of Kandra et al., the Examiner is unable to find a single reference offering a scintilla of a teaching or suggestion of making the combination proposed by the present Applicant. Rex Dolan's later issued patent (namely, U.S. Patent No. 5,967,296) for a belt-style transfer conveyor fails to recognize the advantage that would be afforded by a slave drive, as does the even later Huberty et al. patent cited by the Examiner. Indeed, both patents go to great lengths to describe the requirement for an independent drive, rather than a slave drive. Rather than suggesting the ease with which the technologies could be combined, as posited, the fact that others have

² *In re Fritch*, 23 USPQ2d 1783 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.").

³ *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

⁴ *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

failed to make the combination despite the passage of time is, of course, a strong indicia of non-obviousness that simply cannot be ignored.⁵

In light of the foregoing, Applicant respectfully submits that a *prima facie* case of obviousness is lacking with respect to claim 13 and its progeny. Therefore, reconsideration is respectfully requested.

Claim 23 now recites a conveyor system including a first conveyor supporting a frame, which in turn supports a bed, a drive structure, and a pair of idlers. An endless belt or chain is also associated with the bed, the idler structures, and the drive structure. A tensioner for urges at least one of the idler structures into engagement with the belt or chain. Since none of the cited references disclose or teach such an arrangement, this claim is believed to be allowable as written.

Regarding claim 28, the Examiner does not provide a detailed analysis in support of the rejection made, including a description of how either of the cited references discloses a bed having a transverse support structure received in notches in the frame. Rather, the only allegation made in support of the rejection pertains to the notches; namely, "it is inherent if not obvious to have used a bolt and bolt hole to connect bed supports 56 to the frame 52." However, Applicant's claimed arrangement uses a notch instead of a hole and eliminates the requirement for a bolt in the hole. Since neither of the cited prior art references disclose such a notch (an express requirement of the claim), a *prima facie* case of obviousness is lacking and the rejection of this claim must be withdrawn. See Section 2143.03 MPEP, ch. 2100, p. 133 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

⁵ See *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294 (Fed. Cir. 1997) (holding that "the years of use of [element 1] and of [element 2], without combining their properties, weighs on the side of unobviousness of the combination.").

Claim 31 reads on a conveyor including an endless belt or chain with first and second horizontal portions and a non-horizontal portion. Applicant fails to find such a teaching in either of the cited references, and the Examiner does not contend otherwise. Accordingly, it is believed that a *prima facie* case of obviousness is lacking with respect to claim 31 for reasons similar to those provided for claim 28.

Claim 37 reads on a transfer conveyor for a conveyor system for articles including a first conveyor having a feeding portion and a second conveyor having a receiving portion and a frame between the feeding and receiving portions. The transfer conveyor includes a conveyor chain or belt driven in an endless path and defining a conveying surface for moving the articles from the feeding portion to the receiving portion. Importantly, the transfer conveyor *freely rests by gravity* on the frame and is thus *substantially fully releasable therefrom*.

Clearly, Kandra et al. fails to teach or suggest such a transfer conveyor, including an endless chain or belt defining a conveying surface for moving articles, that freely rests by gravity on any frame and is substantially fully releasable therefrom. Likewise, the secondary Huberty et al. reference provides absolutely no teaching of a transfer conveyor that “freely rests by gravity” on any frame and is thus “substantially fully releasable therefrom” in the event of an article jam. Indeed, the Examiner seemingly takes the inconsistent position elsewhere in the Office Action that the arrangement shown in the Huberty et al. patent is bolted together, and thus cannot possibly meet this limitation of claim 37. Since neither of the cited references thus disclose, teach, or suggest the transfer conveyor of claim 37, a *prima facie* case of obviousness is again lacking.

Finally, new claim 43 is presented to accept the coverage afforded by the allowance of dependent claim 29. Hence, it should be held allowable as well, as should new dependent claims 44-46.

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As it is believed that all claims as presented are in condition for allowance, a notice to this effect is earnestly solicited, including with respect to the withdrawn claims depending from an allowable base claim. In the event that some unforeseen point requires attention, please telephone the Applicant's attorney to expedite issuance of the patent. In the event some fee is due, please debit it from Deposit Account 11-0978.

Respectfully submitted,

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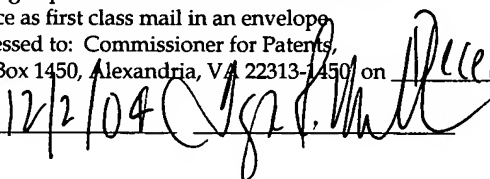
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